

Applicant: T. Allan Hamilton
Serial No.: 09/135,154
Filing Date: August 17, 1998
Docket No.: ZIL-254 (formerly CLB5-B73)

REMARKS

Status of Prosecution:

The listing of claims replaces all prior versions and listings of claims in the application. No claims are amended, cancelled or withdrawn.

The withdrawal of the previous §112, first paragraph, rejection of Claims 53-55 is assumed because the rejection is not repeated in the March 28, 2005 Office Action.

Applicant's previous remarks and comments in the previous Amendments (Amendments of May 26, 2004 and November 10, 2004) are incorporated herein and are not repeated here. Applicant wishes to appeal, but files this RCE so that the additional objective evidence of non-obviousness (submitted herewith) will be in the record.

Discussion:

The undersigned and Applicant do not find the Examiner's arguments in the final Office Action of March 3, 2005 persuasive. The Examiner has, in the undersigned's view, gone through the Patent Office files and with hindsight knowledge of Applicant's invention picked and chosen bits and pieces out of different obscure paper documents, using Applicant's claims as a guide, and has then misapplied the law of obviousness (35 U.S.C. §103) to reject a novel and nonobvious and useful invention. The Examiner appears to believe that the general "extremely well known problem with all electronics that is power consumption" would have been enough to motivate someone out in the real world to combine any pieces of any prior art paper documents you can find the Patent Office that would have resulted in power savings. Applicant has attempted to explain that Applicant's recognition of the problem is part of a proper §103 analysis, but the Examiner has rejected this notion. The Examiner's misapplication of the law is very unfortunate.

The undersigned and Applicant have attempted to show the Examiner that, despite the "analogous" references he has found, that the claimed invention

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was not, is still is not, "obvious" to those of ordinary skill in the IrDA transceiver art. The undersigned has attempted to use logic, has attempted to ask questions to illicit a recognition in the Examiner that no reference recognizes a power consumption problem in an IrDA transceiver that can be fixed, has attempted to cite legal precedent that frowns upon the Examiner's type of thinking, and has attempted to bring real-world objective fact to the Examiner's attention that is inconsistent with the Examiner's conclusion.

In particular, Applicant submitted objective evidence of non-obviousness in the form of the Declaration of Alan Grace. The Declaration (Decl. ¶¶ 1,2, 11) states that Mr. Grace has eight years of experience in the IrDA transceiver field and that Mr. Grace is the principal engineer overseeing the design of all IrDA transceivers made and designed by Zilog. The Declaration (Decl. ¶ 11) states that it is one of Alan Grace's job responsibilities to keep himself aware of the technical capabilities of IrDA transceivers on the market, and that Mr. Grace considers himself knowledgeable (Decl. ¶12) about the capabilities of IrDA transceivers that have been on the market throughout the past six years. The Examiner is requested to recognize that this reflects a great deal of experience, not just with paper documents in the Patent Office and elsewhere, but also with a lot of other information that never makes it into print.

The Declaration (Decl. ¶13) states that to Mr. Grace's knowledge, no company other than Zilog, Inc. (or Calibre before it) has ever produced an IrDA transceiver module having the claimed invention.

This real-world evidence is inconsistent with the position taken by the Examiner. If one of ordinary skill really would be motivated to conserve power as the Examiner asserts, and if it is "obvious" to have an IrDA transceiver with the claimed power saving feature, and if money is to be made in providing the IrDA transceiver on the market, then why is it that no company other than Zilog has such an IrDA transceiver? There are intelligent engineers and good business people working at Vishay. There are intelligent engineers and good business people working at Hewlett-Packard. The Examiner, by maintaining the rejection, is implying that this whole industry is inept and cannot grasp the "obvious".

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The Examiner's states that there is "no factual evidence of nexus" (Office Action, page 10, line16-17). Applicant disagrees. One fact is that the Examiner has not found Applicant's invention disclosed anywhere (this is a §103 rejection, the Examiner has not found the invention in the prior art). Another fact is that, despite the alleged motivation, the Examiner has not found one instance of anyone other than Zilog (and Calibre before it) ever making an IrDA transceiver with the claimed invention. Another fact is that there is now evidence in the record¹ that no company (other than Zilog and Calibre) has ever made an IrDA transceiver with the claimed invention. The fact that nobody other than Zilog has ever made the claimed invention is inconsistent with the Examiner's argument that it would have been "obvious" to save power, and that one of ordinary skill would have been motivated to do it. This is one common sense point about the objective evidence of record for which there is a nexus.

Another separate and independent point is that Zilog customers have purchased IrDA transceivers from Zilog specifically because those IrDA transceivers have the claimed power saving feature. The Declaration of Alan Grace (Decl. ¶10) states that a customer inquired about purchasing Zilog IrDA transceivers that have the IrDA discovery signal detector circuit, and that Mr. Grace suggested that an older Zilog IrDA transceiver (that does not have the claimed invention) would be more appropriate for the customer because it met the customer's needs and was less expensive than the newer Zilog IrDA transceiver having the IrDA discovery signal detector circuit. The customer responded that they wanted the more expensive Zilog IrDA transceiver specifically because the more expensive transceiver has the low-power sleep mode.

The statement in the Office Action that "the declaration provides **no factual evidence** of nexus" is ridiculous. The declaration does too provide factual evidence of a nexus. The customer specifically stated (Decl. ¶9) that the customer wanted to buy the part because of the claimed low-power sleep mode !!

¹ The Declaration of Alan Grace, and now the newly submitted Declaration of Douglas McIntosh.

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That is a clear nexus. It is about as clear a nexus as can be. The Examiner's statement that "one customer is not a very large percentage of the million dollars accounted for in the Declaration" is neither here nor there. For one customer (at least), there is a clear nexus between the claimed invention and the sale. Why does the Examiner refuse to admit this? Why is the Examiner arguing? The Examiner and the Patent Office are supposed to be objective.

The Examiner's subsequent statement (Office Action, page 10, lines 21-22) the "there is no evidence that the only difference between these products is the battery saving feature" is of no moment. Applicant points out there can be a nexus even if the two IrDA transceivers differ in more ways than just the "battery saving feature". The customer said that the customer wanted the more expensive transceiver because of the low-power sleep mode. Whether the customer may have also wanted² the expensive transceiver for some other reason is neither here nor there. The customer specifically said (Decl. ¶9) they wanted the expensive transceiver for the power saving feature. That fact is in the record. That is a clear nexus between the claimed invention and the sale.

More Objective Evidence³ of Non-Obviousness:

The declaration of Mr. Douglas McIntosh of Dart Controls, Inc.⁴ is submitted for the Examiner's consideration. The declaration states that to the declarant's knowledge, the "Zilog ZHX1403MA115TH is the only IrDA transceiver module on the market that has the low-power sleep mode". The declaration states "I am aware of no company other than Zilog that makes, or has ever made, an IrDA transceiver module having the low-power sleep mode". The

² That the customer may have also wanted the part for some other reason is pure conjecture on the part of the Examiner.

³ Only one customer declaration has been obtained to date, but the Examiner is requested to properly consider the difficulty in obtaining such declarations from customers where the result may be a patent usable against the customer. The customer gains nothing by cooperating, and may in fact do something against his later self-interest. Moreover, people do not generally like to sign documents under penalty of perjury unless required to do so.

⁴ As indicated by the second page that is attached to the declaration, Dart Controls Inc. makes and sells motor control accessories and motor drives, tachometers, voltage supplies, speed sensors, signal isolators and other equipment. Dart Controls has produced and shipped more than two million variable speed drives.

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declaration states "The low-power sleep mode described above has been and is an important and significant factor in my company's decision to purchase the ZHX1403MA115TH IrDA transceiver". This is about as clear of a showing of a nexus as you can get. The declaration was made under the penalty of perjury.

Conclusion:

Applicant requests the Examiner to reconsider and withdraw his overreaching⁵ §103 rejections. Just because a station goes into sleep mode does not mean that the IrDA transceiver within it goes into a low-power mode. The terms "sleep", and "wake-up", and the "discovery signal" in the various cited references do not disclose or suggest that an IrDA transceiver module⁶ has a mode in which it cannot receive high speed IrDA signals, and wherein upon detection of the 9600 baud IrDA discovery signal the IrDA transceiver increases an amount of power supplied to the infrared receiver circuitry, thereby enabling the IrDA transceiver to engage in high speed IrDA communication.

⁵ One §103 rejection requires the stitching together of four references.

⁶ Nykanen has software ways (as explained by Applicant at length in the earlier Amendment of Nov. 10, 2004) of achieving power savings. Nykanen does not relate to different power levels in a transceiver module. Nokia does not make transceiver modules. There is no mention of transceiver module design anywhere in Nykanen.

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Reconsideration and allowance is requested. If the Examiner would like to discuss any aspect of this application (Claims 50-60 are pending), the Examiner is requested to contact the undersigned at (925) 621-2115.

I hereby certify that this is being deposited with the U.S. Postal Service as Express Mail "Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated below and is addressed to:

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By 
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Date of Deposit: September 28, 2005

Respectfully submitted,



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